NO.308   001

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OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

    BENSON et al.

Application No.: 09/679,948

Filed: November 4, 2000
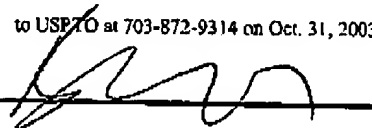
For: System and Method for Manipulating
    Digital Images

Examiner:	Good Johnson, Motilewa
Art Unit:	2672

**RESPONSE TO FINAL OFFICE
ACTION**

I certify that this document was sent by fax

to USPTO at 703-872-9314 on Oct. 31, 2003

Bao Tran

Assistant Commissioner for Patents
Washington, D.C. 20231

Sirs:

    The Final Office Action mailed September 29 2003 rejected claims 1-45 under Section .103(a) as unpatentable over Ofoto.com in view of Bowman-Amuah (USPN 6,477,580). Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

The §103 Rejection

    Claims 1-45 were rejected over Ofoto in view of Bowman-Amuah. The standard for a Section 103 rejection is stated in MPEP Section 706.02(j) is as follows:

        To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

THE REFERENCE ON ITS FACE IS NOT PRIOR ART

In the instant case, the Office Action relied on web pages of Ofoto Help: OfotoNow 2.1 dated March 18, 2003 as prior art. The prior art is defined by Title 35, United States Code, Section 102, which states that a person is not entitled to a patent if the invention was "known or used by others in this country, or was patented or described in a printed publication in this or a foreign country" before the date of invention by the applicant for the patent.

On its face, the reference is not prior art. Although the copyright on the web site recited 1999-2003, **it is common for a software producer to mark the copyright with the date starting from the first version of the software, regardless of new features added in later versions. There is no showing of the pages dated March 18, 2003 that OfotoNow 2.1 is prior art to the instant invention.** Clear and convincing proof of the prior art status of OfotoNow 2.1 needs to be provided, or the rejection should be withdrawn.

THE REFERENCE SINGLY OR IN COMBINATION DOES NOT RENDER THE CLAIMS OBVIOUS

Even if the reference could be considered to be prior art, it cannot render the claims obvious. The Office Action asserted, among others, that Ofoto discloses:

> editing the photo, Help: Ofoto Now 2.1, page 2, and discloses altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5; and synchronizing the local client computer and remote server ... Ofoto discloses uploading the photo on the remote server from the local client, Help: Ofoto Now 2.1, pages 6-7. Page 3 of Office Action.

By noting that "discloses altering a copy of the photo rather than the original photo," the Office Action here admits that Ofoto is contrary to the teaching of the instant invention. Here, Page 5 of OfotoNow 2.1 specifically noted that:

> When you have used the Trim tool, OfotoNow will ask if you want to save your photo before you do anything else. If you don't want to save your changes, you don't have to. Remember: Using the Save command on the trimmed photo permanently alters the original photo! If you are not sure, work on a copy of the photo rather than the original, or use the Save As command to save a copy of the trimmed photo under a new name, leaving the original photo untouched. Red Eye.

To clarify the differences between Ofoto and the present invention, the example of receiving an image with red-eye problem and correcting the problem before submitting the photo on pages 5-6 of OfotoNow 2.1 is contrasted with the operation of the instant invention as follows:

OfotoNow 2.1	Claim 1
editing the photo Help: Ofoto Now 2.1, page 2	identifying an image for processing at a local client computer;
altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5;	manipulating either locally or remotely parameters associated with the image without modifying the image itself;
	sending the image to a remote server;
synchronizing the local client computer and remote server ... Ofoto discloses uploading the	synchronizing the local client computer and the remote server including updating metadata for

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photo on the remote server from the local client,	one of the local client computer and the remote server using metadata of the other.

As shown above, OfotoNow uploads the edited photo. In contrast, the present invention captures edit operations as parameters. The original image is kept intact. Both the parameters and the original image are uploaded to the server. The parameters are uploaded as metadata. Because the original image is saved, the user can undo the changes and/or make additional changes. That capability is simply not present in OfotoNow since it only works with the altered uploaded image.

Ofoto requires the user to work on a copy of the photo rather than the original because saving the change permanently alters the original photo. In contrast, Claim 1 recites "manipulating either locally or remotely parameters associated with the image without modifying the image itself; and synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other."

In one example, the user "alters" the appearance of the image by changing one or more parameters associated with the image. Only the parameters are then recorded as metadata and the image itself is not modified. For subsequent viewing, the parameters are applied to the original image to arrive at the altered image. Hence, the invention does not modify the image but records the parameters to be subsequently applied to the original image to recreate the altered image. In contrast, Ofoto actually modifies the image and, if the user overwrites the original image with the altered image, the original image is lost. Hence, Ofoto recommends that the user saves the altered image as a different file. Thus, Ofoto cannot manipulating either locally or remotely parameters associated with the image without modifying the image itself.

Additionally, as admitted in the rejection, Ofoto is absolutely silent on synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other. There is no suggestion that this be done in Ofoto because Ofoto does not need to use metadata. Rather, each altered image is saved as a separate, stand-alone file and there is no need for metadata to build the altered image from the original image.

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Applicant notes that the present rejection does not establish *prima facie* obviousness under

35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and

support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish

prima facie obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner

must show some suggestion or motivation, either in the Ofoto reference, Bowman-Amuah, or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference so as to

produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Secondly, the Examiner must establish that there is a reasonable expectation of success for the

modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references

teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA

1974). The teachings, suggestions, and reasonable expectations of success must be found in the

prior art, rather than in appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991).

Here, the criteria have not been met: there is absolutely no suggestion or motivation; there is

no expectation of success for the modification, and a plurality of claim limitations are missing.

The office action noted that "Bowman-Amuah discloses sending messages between a

sending system and a receiving system and attaching meta-data to the message. Bowman-Amuah

further discloses the data include identifiers for a type of object, attribute descriptors, and metadata

interpretations, col. 2, lines 19-43." The cited section, the Summary of the Invention, merely shows:

> A system, method, and article of manufacture are described for providing a self-
> describing stream-based communication system. Messages are sent including data between a
> sending system and a receiving system. Meta-data is attached to the messages being sent
> between the sending system and the receiving system. The data of the messages sent from the
> sending system to the receiving system is translated based on the meta-data. The meta-data
> includes a first section that identifies a type of object associated with the data and a number
> of attribute descriptors in the data and a second section that includes a series of the attribute
> descriptors defining elements of the data.
> In one embodiment of the present invention, the sending system and receiving system
> may each be equipped with logic for interpreting the meta-data of the messages. In an
> additional embodiment of the present invention, the elements may be defined in terms of
> size, type, and name.
> In another embodiment of the present invention, one of the systems may be an object-
> based system and one of the systems may be a non-object-based system. In a further
> embodiment of the present invention, both of the systems may be object-based systems. In
> even yet another embodiment of the present invention, both of the systems maybe non-
> object-based systems.

Although metadata is mentioned, Bowman-Amuah does not show the specifics of "synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other."

Here, exemplary operations in one embodiment of the synchronizing operation as disclosed in the instant application are reproduced below:

> Synchronization is performed between the client computer 104 and server computer 102 to ensure a seamless experience for the user. No matter where data is manipulated, whether account, order or image data, either locally or remotely, a synchronization process is executed to allow both remote and local processes to be current.

> As described above, synchronization occurs each time a connection to the user's account at the online photofinisher's website is made. State information of the user account is updated on the user computer and on the web. The state information can include image transfers or upload, the transfer of the image file name, image processing information, image archival information, annotation and back printing information, UI state information, personal template, order information. In one implementation, any input information on the user's computer will be automatically uploaded to the user account on the web without requiring the user to log onto the website. Specification at page 14.

The cited section of Bowman-Amuah merely shows transmission of metadata. However, it does not show the specifics of independent claim 1 with respect to the synchronizing operation. Hence, this is yet another independent basis for traversing the Section 103 rejection.

The dependent claims are allowable since they depend from allowable independent claims. Moreover, they are allowable since neither Ofoto nor Bowman-Amuah shows the specifics as recited in the dependent claims.

In sum, since Bowman-Amuah does not show the claimed elements recited in claim 1, Applicants submit that neither can render obvious any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims.

With respect to the remaining independent claim 43, Bowman does not show additional details of:

> 43.   A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:

Determining if a session is open between the local client computer and the remote server;

Capturing, at the client computer when the session is closed, metadata describing any manipulations by the user of an image;

Capturing, at the remote server when the session is opened, metadata describing manipulations of the image by the user; and

Synchronizing the metadata captured at each of the local client computer and the remote server when the session is open.

Similarly, Bowman-Amuah cannot anticipate claim 44 as it lacks details of image management, archival and printing as follows:

44.   A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:

Dividing image management, archival, and printing functions among the local client computer and the remote server including performing image management at either of the local client computer and the remote server, and performing image archive and printing functions at the remote server; and

Synchronizing image management data between the local client computer and the remote server.

Additionally, Bowman-Amuah lacks the specifics claimed in claim 45:

45.   An apparatus for manipulating a digital image comprising:

Client software for executing on a local client computer including instructions for

identifying an original image for processing at the local client computer,

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uploading the original image to a remote server,

receiving a user selection to locally or remotely process the original image;

if local processing is selected, locally manipulating parameters associated with the original image including storing, on the local client computer, metadata describing the manipulations without modifying the original image,

if remote processing is selected, opening a session with the remote server; and

Remote server software for executing on the remote server including instructions for

receiving the original image,

manipulating parameters associated with the original image in accordance with instructions received from the local processor

storing metadata describing the manipulations without modifying the original image, and

at each session between the local client computer and the remote server, synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

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Respectfully submitted,

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Reg. 37,955